



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,856	04/21/1999	TODD R. COLLART	IACTP005	7668

22887 7590 05/07/2002

DISCOVISION ASSOCIATES  
INTELLECTUAL PROPERTY DEVELOPMENT  
2355 MAIN STREET, SUITE 200  
IRVINE, CA 92614

EXAMINER

RODRIGUEZ, PAUL L

ART UNIT PAPER NUMBER

2125

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

5

# Office Action Summary

Application No.

09/295,856

Applicant(s)

COLLART, TODD R.

Examiner

Paul L Rodriguez

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21,24,25,31,32 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21,24,25,31,32 and 37-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 09 April 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. The amendment filed 4/9/02 has been entered and considered. Claims 21, 24, 25, 31, 32 and 37-44 are presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/9/02 has been entered.

#### ***Drawings***

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 4/9/02 have been approved.

#### ***Claim Objections***

4. Claims 37 and 43 are objected to because of the following informalities: These claims recite the limitation "Universal Resource Locator". Examiner acknowledges the use of the acronym "URL" in the specification however there is no definition of the acronym found in the specification. It is recommended that the applicant provide the definition of URL in the specification to provide proper support of the claim language. Appropriate correction to the specification is required.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 38 recites the limitation "the tracking information" in claim 38 line 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 21, 37, 38, 43 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts et al (U.S. Pat 6,154,773). The claimed invention reads on Roberts et al as follows:

Roberts et al discloses (claim 21) a method for tracking the distribution of content electronically (col. 2 lines 5-18), comprising the steps of detecting a tracking identifier when an

electronic storage medium is accessed by a computer (col. 2 lines 47-55, col. 3 lines 45-52), transmitting, as a function of the tracking identifier having been detected, tracking information to a server computer (col. 4 lines 1-3, figure 2) and determining, as a function of the tracking information having been transmitted to the server computer and as a function of a retailer that sold the electronic storage medium (col. 4 lines 19), an appropriate advertisement to transmit to the computer utilizing logic in the server computer (col. 4 lines 3-27), (claim 37) wherein the appropriate advertisement comprises at least one Uniform Resource Locator (col. 4 line 13, col. 4 lines 56-58, col. 4 line 66 – col. 5 line 5, figure 2 steps 44, 48 and 49A), (claim 38) a system for transmitting advertising based on the content of an electronic storage medium (col. 4 lines 4-13, figures 1&2), comprising means for receiving a tracking identifier that identifies an electronic storage medium that is accessed by a computer (col. 2 lines 47-55, col. 3 lines 45-52), and means for determining, as a function of the tracking information received and as a function of a retailer that sold the electronic storage medium (col. 4 line 19), an appropriate advertisement to transmit to the computer (col. 4 lines 3-27) (claim 43) wherein the appropriate advertisement comprises at least one Uniform Resource Locator (col. 4 line 13, col. 4 lines 56-58, col. 4 line 66 – col. 5 line 5, figure 2 steps 44, 48 and 49A) and (claim 44) wherein the receiving means comprises a server computer (col. 3 line 64 – col. 4 line 3, reference 40).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 24, 25, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al (U.S. Pat 6,154,773) in view of Brindze et al (U.S. Pat 5,822,291).

Roberts et al teaches most all of the instant invention as applied to claims 21 and 28 above and also teaches performing table look up (col. 4 lines 3-6). Roberts et al fails to teach performing a table lookup to determine one or more authorized titles and writing a transaction to a database memorializing processing.

Brindze et al teaches performing a table lookup to determine one or more authorized titles (col. 9 lines 25-49) and writing a transaction to a database memorializing processing (col. 5 lines 1-7, col. 9 line 35 – col. 10 line 20, col. 12 lines 1-18).

Roberts et al and Brindze et al are analogous art because they both provide tracking of individual electronic storage medium usage.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize look up of authorized titles and memorializing transactions of Brindze et al in the CD-ROM interactive network which provides appropriate advertising of Roberts et al because Brindze et al teaches controlling the authorization and use of electronic media to stop piracy of content, improved marketing by retailers and tracking of individual copies of mass produced works (col. 1 line 10-50).

11. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al (U.S. Pat 6,154,773) in view of Takahashi (U.S. Pat 5,878,020).

Roberts et al teaches most all of the instant invention as applied to claims 21 and 28 above and also teaches wherein the electronic storage medium has a tracking identifier and wherein a digital code is part of the tracking identifier (col. 3 lines 50-51), Roberts et al fails to

Art Unit: 2121

teach the electronic storage medium tracking identifier is in a burst cut area and a digital code is in the burst cut area.

Takahashi teaches an optical disc electronic storage medium tracking identifier is in a burst cut area (Abstract, figure 15, figure 21, col. 20 lines 32-65) and a digital code is in the burst cut area (figure 15, figure 21, col. 20 lines 32-65).

Roberts et al and Takahashi are analogous art because they both store content information on an optical disk.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the Burst Cut Area of Takahashi in the CD-ROM interactive network which provides appropriate advertising in Roberts et al because Takahashi teaches increased speed for file management of mass storage devices such as an optical disc (col. 1 line 63 – col. 3 line 58).

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 21, 24, 25, 31, 32 and 37-44 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Edenson et al (U.S. Pat 6,198,875) – teaches identification information on an electronic storage medium which is used to track the use of the electronic storage medium, teaches providing appropriate advertising feeds to target audiences and the system protects retailers from fraud.

Schneider (U.S. Pat 5,987,464) – teaches an electronic storage medium which is used to load data into a computer, allows loading from a remote source of new issue or version information, advertising data, and subscription renewal information from a remote server.

Hudetz et al (U.S. Pat 5,978,773) – teaches the use of identification codes on retail items which are linked to URLs. The access to the internet provides information about the product and related products.

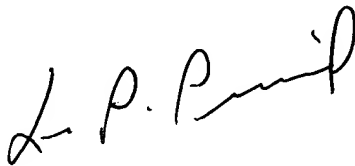
Nerlikar et al (U.S. Pat 5,905,798) – teaches identification information on a DVD used to access advertisements.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399. The examiner can normally be reached on 6:30 - 4:00 M-Th and alternate F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (703) 308-0538. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Paul L Rodriguez  
Examiner  
Art Unit 2121



**LEO PICARD**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**

PLR  
April 24, 2002